

REMARKS

Initially, Applicant's Attorney would like to express his gratitude to the Examiner for permitting an interview after final in the present case on January 25, 2005. The Examiner's assistance was greatly appreciated. Additionally, the Examiner's courteous demeanor was appreciated.

Next, Applicant respectfully requests reconsideration of the final rejection of some of the claims in the present application and entry of the above amendments. Applicant respectfully submits that the amendments above place the application in condition for allowance.

After entry of the proposed amendments above, claims 2-26 would be currently pending. While Applicant respectfully traverses the rejection of claim 1 under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 1,977,013 to Robb, hereinafter ("Robb"), in view of the fact that the rejection was made final, Applicant has above-requested the cancellation of claim 1. Cancellation of claim 1 is without prejudice and Applicant hereby reserves the right to file continuation applications directed to the subject matter of claim 1.

Applicant notes with appreciation that the Examiner, in the final Office Action, indicated that claims 13-26 are allowed and that claims 3-9 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As a result, the only claims rejected in the final Office Action were claims 1, 2, 10, 11, and 12.

Concerning claim 1, Applicant has, as discussed above, requested that claim 1 be cancelled. Applicant will address claim 2, the subject of the request for reconsideration, below. An amendment to Claim 11 has been requested above to change its dependence from claim 1 to claim 2.

Claims 10 and 12 were discussed during the telephone interview and agreement was reached as to their allowability, provided they were rewritten in independent form. Applicant has above-requested such amendments. More particularly, it was discussed, and agreed, that Robb does not disclose a plurality of bolts through bores in the first plate member for coupling the device to the trailer, as required by Applicant's claim 10. Similarly, it was discussed, and agreed, that Robb does not disclose a recess in the upper surface of the first plate member adjacent the opening for improved coupling, as required by Applicant's claim 10.

Regarding claim 2, Applicant's attorney submitted that claim 2 should be allowable as filed because it requires that the means for coupling the device to the trailer must include a clamp member. Applicant's attorney submitted that Robb does not disclose a clamp member for coupling the device to the trailer as required. The Examiner, in the final Office Action and again in the interview, indicated that Robb discloses a clamp member, namely, locking members 4, best illustrated in Fig. 4. Applicant respectfully requests reconsideration of this rejection.

The point of disagreement is quite simple. Applicant submits that, in order to anticipate claim 2, the clamp 4 in Robb **must** perform or be capable of performing the claimed the claimed function of coupling the device to the trailer. Applicant's claim 1 (and now, if entered, amended claim 2) includes a means plus function claim under 35 U.S.C § 112, paragraph 6. The Examiner, on the other hand, has taken the position that Robb need only disclose a clamp somewhere in the patent and that it is irrelevant whether it can perform the claimed function.

Applicant concedes that the intended use of a claimed element or apparatus is not sufficient to make a claim allowable over prior art that discloses that same structure but fails to disclose the intended use. However, this is not the case. Applicant specifically used a means plus function claim in claiming his invention. As such, the function is a part of the claim and must be found in any reference before that reference can be used to anticipate the claim. The case law is quite clear on this point.

In 1994, the Federal Circuit reversed a decision of the Patent and Trademark Office and held that means plus function limitations must be considered when determining the patentability of claims. In re Donaldson Co., 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994). In response to the Donaldson decision, the Patent Office designed new examination guidelines for determining the patentability of means plus function claims and published them in the Official Gazette. 1162 Official Gazette 59 (1994). In the new guidelines, the Patent Office instructed Examiners that, in order to establish a prima facie case of anticipation of a means plus function claim, a reference **must** disclose a prior art element that performs the same function. The clamp 4 in Robb does not disclose the claimed function of coupling the device C to the trailer A, but instead is for coupling the device C to the tractor E. See Fig. 5 and the discussion beginning at line 100.

In Robb, the device C is coupled to the trailer A by the central axis journal member 10 that permits the device C to rotate thereabout. If the clamp 4 was used to couple the device C to the trailer A, the functionality of the device C would be lost as it would no longer be able to rotate or connect the trailer A to tractors with kingpins extending upwardly therefrom.

To anticipate claim 2, the clamp in Robb has to perform the claimed function of coupling the device to the trailer. It does not. Accordingly, the rejection of claim 2 under § 102 is improper and should be withdrawn. Such action is respectfully requested.

Further, the clamp 4 in Robb is not an equivalent of the clamp claimed in claim 2 because it does not perform substantially the same overall function, in substantially the same way, to obtain substantially the same overall result as claimed. See the Examination Guidelines at 1162 Official Gazette 59, 60-61 (1994). “The limitations which must be met by an anticipatory reference are those set forth in each statement of function Such a limitation cannot be met by an element in a reference that performs a different function, even though it may be part of a device embodying the same general overall concept.” RCA Corp. v. Applied Digital Data Sys., 730 F.2d 1440, 221 USPQ 385, 389 (Fed. Cir. 1984).

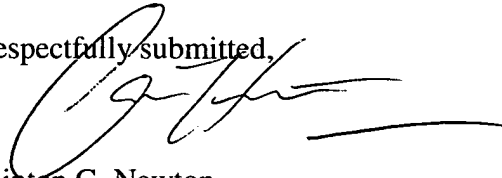
With claim 1 cancelled, claim 2 allowable, claim 11 dependant therefrom and claims 10 and 12 rewritten in independent form, all pending claims in the present application will be in condition for allowance after enter of the above-requested amendments. Such action is requested.

It should be noted that, while the Patent Office required language of “presently amended” has been included above to indicate the status of claims 2, 10 and 12, Applicant submits that claims 2, 10 and 12 have in fact not been amended, as their scope remains identical to their scope at filing. Instead, claims 2, 10 and 12 have simply been rewritten as independent claims. Their scope, however, has not been amended.

If the Examiner believes that a telephone conference will in any way expedite the handling of this case, he is invited to call Applicant's undersigned attorney at (800) 821-7962 for an issue resolving conference.

Applicant encloses herewith a Petition for Extension of Time of one month. The Commissioner is hereby authorized to charge the \$60 fee associated with the Extension and the \$200 for the two additional independent claims to deposit Account No. 19-2112. Should any additional fees be necessary, the Commissioner is hereby authorized to charge any additional amounts required, or credit any overpayment, to deposit Account No. 19-2112.

Respectfully submitted,



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